

The application for reissue is complete in all respects and in allowable form.

Applicants respectfully assert that the error relied upon in support of the reissue application is an error upon which a reissue can be based. Applicants respectfully assert that the subject matter of claims 16-63 cover the invention disclosed in the original patent. Reissue is proper and Applicants respectfully request that the reissue application be allowed with claims 1-63, as pending.

### Claims

Claims 1-63 are in the application.

Claims 1-15 in U.S. Patent No. 5,652,263 refer to skin care compositions that comprise a water-in-oil emulsion, a retinoid and a stabilizing system.

Claims 16-63, which are added to claims 1-15 in the reissue application, refer to methods of manufacturing emulsion skin care compositions.

The subject matter of new claims 16-63 is supported throughout the specification of U.S. Patent No. 5,652,263. In the specification in the section entitled "FIELD OF THE INVENTION", column 1, lines 15-19 states

More particularly, the present invention relates to chemically stable skin care compositions comprising a water-in-oil emulsion and certain retinoids **and to methods for making such compositions.**

(Emphasis added.) In describing how to make compositions of the invention, the specification describes at column 7, lines 28-40 a preferred method of making the compositions, specifically stating at column 7 lines 34-36

It is preferred that the portions be prepared under an oxygen depleted atmosphere such as a nitrogen or argon gas blanket.

In the paragraph preceding the sections entitled Example I through Example XV, the specification states at column 7, lines 41-44

The advantages of the invention and specific embodiments of the skin care compositions **prepared in accordance with the present invention** are illustrated by the following examples.

(Emphasis added.) The fifteen (15) examples which follow each refer to skin care compositions and the methods by which they were made.

### **The Objection to Claims 16-63**

As stated in the Official Action dated October 24, 2000, claims 16-63 have been objected to because the reissue oath/declaration is allegedly defective for the reasons stated in the Office

Action dated February 22, 2000. The Office Action dated February 22, 2000 states:

The reissue oath/declaration filed with the application is defective because the error, which is relied upon to support the reissue application, is not an error upon which a reissue can be based. See 37 CFR 1.175(a)(1) as well as MPEP § 1414 and § 1450. In particular, failure to timely file a divisional application is not to be an error causing a patent to be partially inoperative by reason of claiming less than they had a right to claim. In the instant case, the added claims are not directed to any invention disclosed in the

original patent as evidenced by the claims in the original patent (footnote citing *In re Rowland* 187 USPQ 487 (CCPA 1975)). The newly added claims are directed to processes of making a composition while the original claims were drawn to a composition. In addition, the new claims are not drawn to a process of making the same composition that was patented but rather one of much different scope.

Applicants filed a request for reconsideration on May 22, 2000 requesting the withdrawal of the objection to claims 16-63 in the Office Action dated February 22, 2000 and examination of the claims on the merits. Applicants urged that no restriction requirement was made during the prosecution of the application from which U.S. 5,652,263 issued nor was any restriction requirement made during the prosecution of any of the parent applications to which priority is claimed. Applicants cited *In re Watkinson*, 900 F.2d 230 (Fed. Cir. 1990), for its holding that acquiescence to a restriction requirement is not a correctable error and distinguished the facts of *Watkinson* from the facts of the instant application in which no restriction requirement was made during prosecution of any of the related applications.

In the Office Action dated October 24, 2000, in agreement with Applicants' position, the Examiner acknowledged that *In re Watkinson*, was factually distinguishable over the instant application. The Examiner urged that *In re Mead*, 198 U.S.P.Q. 412 (Fed. Cir. 1978), was controlling, stating that

The correct test was set forth in *In re Mead* which stated that the entire disclosure must be considered when determining what Applicant intended to claim and whether the invention now claimed is directed to a different invention (which would not be a correctable error) or some embodiment of the earlier

claimed invention (which would be a correctable error).

The Examiner concluded on page 2 of the Official Action that because claims 16-63 are directed to methods rather than compositions, which are claimed in the original claims 1-15, and since the limitations in the composition claims are different from those in the method claims, "the instant claims are not directed to a different embodiment of the original invention". The Examiner then noted

In addition, while the specification sets forth a few specific examples wherein argon was used as a part of the process, there does not appear any intent to claim a process wherein the single process step is the use of argon, i.e. that argon was a critical feature to the retinoid compositions being examined. It is noted that Applicant's listing of the page numbers wherein various embodiments of the claimed invention may be found is not persuasive either of Applicant's intent to file or of written description since the test for both is not when (or if) each individual embodiment was set forth but when the invention (or inventions) as a whole was conveyed.

Accordingly, the reasons provided for objecting to the addition of claims 16-63 are summarized as follows. First, that the reissue oath/declaration filed with the application is defective because the error that is relied upon to support the reissue application is an error upon which a reissue can be based. Second, the added claims are not directed to an invention disclosed in the original patent. Third, the instant application fails to comply with *In re Mead* which requires that the newly added claims be directed at a different embodiment of the original claimed invention. Applicants respectfully disagree.